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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/800,520	03/08/2001	Hideo Iba	423-59	5027

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EXAMINER

MCGILLEM, LAURA L

ART UNIT PAPER NUMBER

1636

DATE MAILED: 12/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action Before the Filing of an Appeal Brief	Application No. 09/800,520	Applicant(s) IBA ET AL.	
	Examiner Laura McGillem	Art Unit 1636	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 24 October 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____
Claim(s) objected to: 31, 41, 58 and 64.
Claim(s) rejected: 34, 41-45 and 58-69.
Claim(s) withdrawn from consideration: 46 and 53-57.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s).
13. ☒ Other: See Continuation Sheet.


DAVID GUZO
PRIMARY EXAMINER

Continuation of 11. does NOT place the application in condition for allowance because: Applicants present arguments regarding the objection of claims 34, 41, 46, 58 and 64 for the misspelling of "destabilizing", however, the objection is being maintained because the word "destabilizing" remains misspelled in the claims. For example, instant claim 34 recites "destablizing", which should read "destabilizing". Applicants traverse the rejection of claims 58-69 under 35 USC 112, 2nd paragraph for indefiniteness of the phrase "foreign gene" and cite US Patent 5,304,640 to provide a definition of foreign gene. This rejection is being maintained because, while the inventors of U.S. Patent 5,304,640 have provided a definition of "foreign gene", inventors of the instant application have not sufficiently defined "foreign gene" in their own specification. The fact that a term is defined in a patent in a particular fashion does not mean that the definition is binding on all subsequently filed patent applications.

Continuation of 13. Other: The Form PTO-1449 filed 10/24/05 will not be entered or considered. Applicants submit that, as per MPEP 2001.06(b), Examiner must indicate in the first Office action whether prior art in an earlier application has been reviewed and accordingly, no separate citation of the same prior art need be made in the later Application. However, the MPEP does not require that a listing of each of the cited references be included in an acknowledgement of a review of the prior art in an earlier application. Furthermore, submission of Form PTO-1449 in an After Final Amendment is non-compliant with 37 CFR 1.97 (see MPEP 609), which reads, in part, that "An information disclosure statement shall be considered by the Office if filed ...before the mailing date of any of a final action under § 1.113, a notice of allowance under § 1.311, or an action that otherwise closes prosecution in the application, and it is accompanied by one of: (1) The statement specified in paragraph (e) of this section; or (2) The fee set forth in § 1.17(p)." The PTO-1449 form was filed after the mailing date of a final action and was not accompanied by a fee. Regarding the double patenting rejection of claims 34, 41-45 and 64-69 and subsequent filing of a terminal disclaimer on 4/27/2005, it should be noted that the terminal disclaimer has been approved.